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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/562,998

05/02/2006

Vincent Cool

05-1083

3592

20306

7590

01/15/2010

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EXAMINER

NIEBAUER, RONALD T

ART UNIT

PAPER NUMBER

1654

MAIL DATE

DELIVERY MODE

01/15/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<p><b>Application No.</b> 10/562,998</p>	<p><b>Applicant(s)</b> COOL ET AL.</p>	
	<p><b>Examiner</b> RONALD T. NIEBAUER</p>	<p><b>Art Unit</b> 1654</p>	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 18 December 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 3-14, 16 and 19.  
Claim(s) withdrawn from consideration: 15.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Ronald T Niebauer/  
Examiner, Art Unit 1654

/Anish Gupta/  
Primary Examiner, Art Unit 1654

Continuation of 3. NOTE: The amendments raise new issues that would require further consideration and/or search. Applicants have amended base claim 3 to recite that the salt is added in step a), b), or c). However, the previously examined claim 3 did not specify at which step the salt was added. As such the previously examined claims were interpreted such that the salt could be added at any stage of the process and since claim 3 used 'comprising' language the claim was interpreted such that the salt could be added at any step of the process. Thus, the previously cited art will have to be reconsidered to determine whether or not it reads on the instant claims. In other words, claim 3 includes a new requirement (i.e. that the salt be added in step a, b, or c) that was not present in claim 3 previously. Since the new requirement was not present in claim 3 previously, claim 3 will have to be reconsidered. It is noted that Birr (US 4,290,943 see page 6-7 of the final rejection) expressly teach benzyltrimethylammonium hydroxide as recited in claim 3. A cursory review of Birr does not clarify whether or not Birr specifically teach the use of benzyltrimethylammonium hydroxide in steps a), b), or c) of the instant claims. Thus, Birr will have to be reconsidered in light of the claim amendments. If Birr does not expressly teach the addition at the recited steps, it will have to be determined whether or not Birr obviates the instant claims. If Birr does not obviate the claims, an additional search of the prior art will need to be conducted. As such the amendments do not merely require a cursory review (see MPEP section 714.13 II). The amendments raise new issues that require further consideration and/or search. As noted in the previous office actions, in accord with section 803.02 of the MPEP the markush-type claims were previously examined to the extent necessary to determine patentability. .

Continuation of 11. does NOT place the application in condition for allowance because: In the instant case the amendment has not been entered because the amendment raises new issues that require further consideration and/or search. As discussed above, Applicants have amended base claim 3 to recite that the salt is added in step a), b), or c). However, the previously examined claim 3 did not specify at which step the salt was added. Since the amendment has not been entered, the previous rejections (see final rejection 10/27/09) remain of record. It is noted that although the amendment has not been entered it appears that the amendment is sufficient to overcome the 112 2<sup>nd</sup> rejection. As discussed above, the art rejections will have to be reconsidered based on the claim amendments. It is noted that Birr (US 4,290,943 see page 6-7 of the final rejection) expressly teach benzyltrimethylammonium hydroxide as recited in claim 3. A cursory review of Birr does not clarify whether or not Birr specifically teach the use of benzyltrimethylammonium hydroxide in steps a), b), or c) of the instant claims. Thus, Birr will have to be reconsidered in light of the claim amendments. If Birr does not expressly teach the addition at the recited steps, it will have to be determined whether or not Birr obviates the instant claims. If Birr does not obviate the claims, an additional search of the prior art will need to be conducted.